REMARKS

Claims 1-20 are currently in the application.

I. INFORMATION DISCLOSURE STATEMENT

The Applicants have reordered Information Disclosure Statement document No. 65 ("Cisco IOS Release 12.0 Network Protocols Configuration Guide, Part I", Configuring IP Addressing, Cisco Systems, 1998, pages P1C-7 to P1C-58). The Applicants will resubmit the referenced document when it is received for the Examiners consideration in review of the current application.

II. PROVISIONAL DOUBLE PATENTING REJECTION

The Examiner has provisionally rejected claims 1-7, 10-14, and 19-20 as being unpatentable over claims 1-39 of copending Application No. 09/270967. As this is a provisional rejection based on a pending application, the Applicants note the rejection and reserve the right to address it if Application No. 09/270,967 is allowed and the rejection is maintained.

III. CLAIM REJECTIONS UNDER 35 U.S.C. §103

Claims 1-20 stand rejected as being unpatentable over Tsuruoka (U.S. Patent No. 6,101,189) in view of Ylonen *et al.* (U.S. Patent No. 6,438,612 B1). The Applicants traverse the Examiners contention that there is suggestion to combine Tsuruoka and Ylonen. As discussed below, the combination of these two references is improper and yields an inoperative combination, thereby also making the Examiner's rejection under §103 improper as well.

Tsuruoka teaches global network address translation through a gateway, not distributed network address translation. To perform the Tsuruoka global network address translation,

McDONNELL BOEHNEN
HULBERT & BERGHOFF
300 SOUTH WACKER DRIVE, 32ND FLOOR
CHICAGO, IL 60606
(312) 913-0001

Tsuruoka requires converting, modifying, and determining content of packets that pass through the gateway. (*See* Tsuruoka, col. 12 lines 59-67; col. 13 lines 3-12 and lines 55-60; col. 14 lines 5-25 and lines 36-40.) Ylonen teaches a secure communication tunnel established between two virtual routers on two separate virtual networks with IPSEC protocols utilizing IKE SA, or ESP transforms. (*See* Ylonen, col. 4 lines 39-67 and col. 5 lines 1-4.) However, Ylonen does not disclose, and in fact, teaches away from, any conversion or modification of the packets passing through these virtual routers/gateways.

As known in the art, once an IP packet is protected by IPSEC, it cannot be converted or modified anywhere along its path from the transmitting computer device to the receiving computer device. Consequently, Tsuruoka used in conjunction with Ylonen renders Tsuruoka inoperable; similarly, Ylonen used in conjunction with Tsuruoka renders Ylonen inoperable, as Tsuruoka requires the modification of IP packets during routing of the packets between the gateway and a computer device, while Ylonen requires that IP packets remain unmodified during transmittal. In effect, Ylonen teaches away from the art taught in Tsuruoka (and vice-versa).

A proposed modification of a prior art reference with another reference is inappropriate when the modification renders the prior art reference inoperable for its intended purpose. *In Re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1894). Moreover, evidence showing there is no reasonable expectation of success supports a conclusion of nonobviousness. *In re Rinehart,* 531 F.2d 1048, 189 USPQ 143 (CCPA 1976). Modifying Tsuruoka with Ylonen, or vice-versa, would render either of the references inoperable for its intended purpose, and have no reasonable expectation of success. Therefore, the combination of these two references is improper and the rejection of the present claims under §103 must be withdrawn.

McDONNELL BOEHNEN
HULBERT & BERGHOFF
300 SOUTH WACKER DRIVE, 32ND FLOOR
CHICAGO, IL 60606
(312) 913-0001

III. SUMMARY

Applicants respectfully submit that, in view of the remarks above, the present application, including claims 1-20, is in condition for allowance and solicits action to that end.

If there are any additional matters which may be resolved through a telephone interview, the Examiner is respectfully requested to contact Applicants' undersigned representative.

Respectfully submitted,

McDonnell Boehnen Hulbert & Berghoff

Date: 7-29-03

By: _____

Sean M. Sullivan
Reg. No. 40,191

McDONNELL BOEHNEN
HULBERT & BERGHOFF
300 SOUTH WACKER DRIVE, 32ND FLOOR
CHICAGO, IL 60606
(312) 913-0001